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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,147	03/11/2004	Steven J. Mahaffey	23486/P-6255	5577
27784	7590	07/28/2004	EXAMINER	
LAW OFFICE OF LAWRENCE E. LAUBSCHER, JR. 1160 SPA ROAD, SUITE 2B ANNAPOLIS, MD 21403			LEGESSE, NINI F	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/798,147

Applicant(s)

MAHAFFEY ET AL.

Examiner

Nini F. Legesse

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 11-16 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 5, 6, 8, 9, 11, 13, 14, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over W. N. Beat (US Patent No. 1,538,312) in view of W. Dunn (US Patent No. 1,541,126).

- **With respect to claim 1**, Beat discloses a golf club head including an upper surface, a lower surface (10), a front ball striking face (8), a curved rear surface (14) and toe (7) and heel (6) surfaces between said striking face (8) and said curved rear surface (14); and a peripheral weight (this weight is a combination of items 13,16, and 13 as shown on Fig. 7) connected with said body on at least one of said rear (Fig. 2) and lower surfaces (Fig. 3) in order to increase the moment of inertia of the club head when used to strike a golf ball, said peripheral weight (16) having a variable weight distribution throughout its length (column 2 lines 90-110), whereby the weight toward said toe and heel surfaces of the club head can be adjusted in accordance with the weighting of said peripheral weight (column 2, lines 99-102). However, Beat fails to explicitly state if the club head body is made of metal. Dunn teaches metallic heads for drivers and brassies (see column 1, line 46). Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to provide the golf club head of Beat with a metal body in order to provide a club that is long lasting.

- **With respect to claim 2**, Beat discloses wherein said body rear surface (14) contains an elongated recess that extends between said toe and heel surfaces (11) and also the peripheral weight which is a combination of items 13, 16, and 17 as shown on Fig. 7 has a C-shaped configuration when viewed from the left side.
- **With respect to claim 5**, Beat discloses wherein said peripheral weight comprises a housing (plugs 17) containing a plurality of chambers (18) along its length for selectively receiving weight members to alter the weight distribution thereof (see column 2, lines 99-102).
- **With respect to claim 6**, Beat discloses wherein at least one weight member (19) is integrally arranged with said peripheral weight at a selected location along the length thereof (see Fig. 5).
- **With respect to claim 8**, Beat discloses a golf club head including an upper surface, a lower surface (10), a front ball striking face (8), a curved rear surface (14) and toe (7) and heel (6) surfaces between said striking face (8) and said curved rear surface (14) and a peripheral weight (16) connected with said body on at least one of said rear (item 16 is connected to rear surface 14 as shown on Fig. 2) and lower surfaces (the bottom extension 13 of item 16 is connected to bottom surface 10) in order to increase the moment of inertia of the club head when used to strike a golf ball, said peripheral weight (16) having an annular

configuration (item 17 as shown on Fig. 7 has annular configuration) and being connected with said body lower surface (10) in order to lower the center of gravity of the club head (column 2, lines 59-62). However, Beat fails to explicitly state if the club head body is made of metal. Dunn teaches metallic heads for drivers and brassies (see column 1, line 46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a golf club head with a metal body in order to provide a club that is long lasting.

- **With respect to claims 9 and 14**, Beat teaches wherein the weight (the combination of the weight components as shown on Fig. 7) includes an upwardly extending portion (16) at the rear thereof, which extends upwardly over a portion of the rear surface of the body (see Figs. 2-8).
- **With respect to claim 11**, Beat teaches that the greater weight is concentrated in a rear portion of the peripheral Weight (column 3, lines 26-31).
- **With respect to claim 13**, Beat discloses an annular peripheral weight (item 17 as shown on Fig. 7 has annular configuration) connected with said body lower surface in order to lower the center of gravity of the club head (column 2, lines 6-8 indicates that there is an insert that is located practically across the entire back of the club face and an insert located in the lower portion of the club).
- **With respect to claim 15**, Beat shows peripheral weight (16) to be adjustable (see column 2 lines 90-110).

**Claims 7, 12, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 8 above, and further in view of Austin et al. (US Patent No. 5,803,830).

Beat discloses the invention as recited above but fails to show a concave slot wherein a recess is arranged within said slot. Austin teaches a concave slot around the peripheral of the head (see Figs. 13 and 14). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide concave slot as taught by Austin in the Beat device in order to improve the aerodynamic characteristics of the golf club head.

#### ***Allowable Subject Matter***

**Claim 10** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

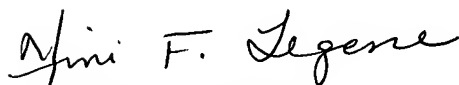
#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nini F. Legesse

07/14/04